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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,649	01/27/2004	Younger Ahluwalia	03137.000006	4007

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

MAIL DATE	DELIVERY MODE
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01/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/766,649	Applicant(s) AHLUWALIA ET AL.	
	Examiner Victor S. Chang	Art Unit 1771	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: 1-20.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1, 7, 13 and 16-20.
 Claim(s) withdrawn from consideration: 2-6, 8-12, 14 and 15.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached NOTE.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

NOTE

1. Applicants argue at Remarks pages 4-6 that there is no suggestion or motivation in any of the cited references to alter Horner to produce a composite material according to the present claims, and the combination of prior art amounts to 'obvious to try' or 'hindsight reconstruction'. However, in Office action mailed 10/2/2006 page 3, the examiner has pointed out that Lynn shows in Fig. 3 a preferred embodiment of laminated facer comprising aluminum foil layers for providing an especially high insulation value. It would have been obvious to one of ordinary skill in the art of insulation board to modify the foamed facer of Horner with a layer of laminated (adhered) aluminum foil, as taught by Lynn, motivated by the desire to obtain an improved insulation value. Clearly, the motivation has been taught by prior art for obtaining improved property and with a reasonable expectation of success at the time the invention was made. Further, since any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, and the basis of rejection takes into account only knowledge which was within the level of ordinary skill at the time the invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

Applicants argue at page 6 that there is no teaching in Horner of utilizing prefabricated microcells. However, in the previous Office action the examiner has pointed out at page 3 that since Horner teaches that various fillers can be included in the prefoamed thixotropic polymer latex, and Morgan teaches that suitable fillers include resinous microballoons (prefabricated microcells), glass beads, clays, etc. It would have been obvious to one skilled in the art to also incorporate microballoons in the prefoamed composition of Horner as a filler material, as taught

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incorporate microballoons in the prefoamed composition of Horner as a filler material, as taught by Morgan, because the selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination. See MPEP § 2144.07.

Applicants argue at pages 7-8 that Horner teaches away from the combination with Lynn and from the present invention, because Horner teaches that the inventive facer members eliminate the need for heat retaining members at the top and bottom of insulation boards and that aluminum foils cause disruption, delamination and warping and because they are costly. However, while Horner teaches that the facers members eliminate the need for heat retaining members at the top and bottom of the stack and significantly reduces the problem of the board's susceptibility to cold temperature delamination [col. 4, line 67 through col. 5, line 4], i.e., the need for aluminum layers as outer layers at the top and bottom of the laminate stack is eliminated, nowhere does Horner teach away from including aluminum foils as heat insulation improving layers between the outer foamed facers and foam core, as taught by Lynn. The examiner asserts that the combined teachings of Horner and Lynn render the instant invention obvious, motivated by the desire to obtain an improved insulation value. Further, Lynn has acknowledged that the disadvantage associated with using aluminum foil facer alone stems from its fragility, which can result, e.g., in foil breakage during foam board manufacture [col. 1, lines 32-36], and teaches a preferred embodiment in Fig. 3 for overcoming the disadvantage [col. 1, lines 48-51]. There is nothing to prevent one of ordinary skill in the art of facer to combine the teachings of Horner and Lynn, and renders the instant invention obvious. As to the delamination, warping and deterioration to the wood laminate, there is no evidence that Lynn's sandwiched aluminum foil would have caused similar problems. Finally, regarding the cost of

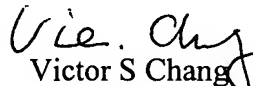
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aluminum foil, the applicants are reminded that 1) applicants appear to argue against their own invention as undesirable; 2) Lynn has in fact stated to the contrary that aluminum foil is an inexpensive facer material [col. 1, lines 30-31], and cost obviously does not prevent one skilled in the art from providing a product with an improved performance, as taught by Lynn.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Victor S Chang
Examiner
Art Unit 1771

1/8/2007